UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,870	11/20/2000	Eric Engstrom	112076-138351	2255

25943   7590   10/05/2004

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EXAMINER
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ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/718,870	ENGSTROM ET AL.
	Examiner	Art Unit
	Kieu D Vu	2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 August 2004</u>.
2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-24* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
    application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the RCE field 08/03/04.

2.   Claims 1-24 are pending.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless :
> (b) the invention was patented or described in a printed publication in this or a foreign country or
> in public use or on sale in this country, more than one year prior to the date of application for
> patent in the United States.

4.   Claims 1, 3-6, 11, 13-16 and 21-24 are rejected under 35 U.S.C. 102(b) as being

anticipated by Horvitz et al (USP 5,880,733).

Regarding claims 1, 11 and 21, Horvitz teaches displaying execution results of

first one or more applications in a first face (front plane) of a metaphoric desktop (see

the front plane 38 in Fig. 3), the first face being a current visible face of the metaphoric

desktop (Fig. 3 shows that front plane 38 is a current visible face of the desktop),

morphing the metaphoric desktop from the first face to a second face of the metaphoric

desktop with the second face becoming the current visible face (see the transformation

of caused by the push back button 64; col 3, lines 61-65); displaying execution results of

second one or more applications in the second face of the metaphoric desktop (see the

back plane 44 in Fig. 3) (also see lines 45-59 of col. 10).

Regarding claims 3, 13 and 22, Horvitz teaches the transition (morphing) from

the first face to the second face as the front plane is transformed (morphed) to the back

plane in response to detection of a predetermined event (event of selecting push back

button 64) (see col. 12, lines 31-50, also see figure 13, col. 19, lines 32-61).

Regarding claims 4, 14 and 23, Horvitz further teaches that planes can be

rotated 90, 180, 270 or 360 degrees over the vertical axis as illustrated in figure 13.

Regarding claims 5, 15 and 24, Horvitz further teaches that plurality of the

planes (plurality of portion of metaphoric desktop) can be rotated 90, 180, 270 or 360

degrees over the vertical axis as illustrated in figure 13.

Regarding claims 6 and 16, Horvitz further teaches first and second faces are

front face (38 in figure 3) and back face (44 in figure 3).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
> in section 102 of this title, if the differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

6.   Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Horvitz et al (USP 5,880,733) and Boneh et al (hereinafter "Boneh", USP 6760750).

Regarding claims 2 and 12, Horvitz differs from the claim in that Horvitz neither

teaches second application is on-line application nor teaches monitoring the apparatus

for being connected on-line. However, such feature is known in the art as taught by

Boneh. Boneh teaches a system for updating a web page with rapidly changing

information (col 3, lines 31-32). Boneh teaches that the system includes an invisible

pane and a visible pane wherein the visible pane is updated with the status of the on-line application (col 4, lines 5-16). It would have been obvious to one of ordinary skill in the art, having the teaching of Horvitz and Boneh before him at the time the invention was made to include a web-browser as a windows applications in Horvitz's desktop with the motivation being to enable world wide web access for Horvitz's desktop.

7.   Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (USP 5,880,733) and Taylor et al (hereinafter "Taylor", USP 6552733).

Regarding claims 7 and 17, Horvitz teaches storing pictorial representation of said first execution results of the first one or more applications into a standard display screen buffer by a graphic service (col 11, lines 43-46). Horvitz differs from the claim in that Horvitz does not explicitly specify that the display of the execution result of the second applications comprises redirecting the graphics service to store pictorial representations of the results of the first application to an alternate display buffer and to store pictorial representations of the results of the second application to the current display buffer. However, the feature of multiple position buffers is known in the art as taught by Taylor. Taylor teaches a system for morphing which includes multiple position buffers which are associated with morphing operations (col 9, lines 13-18). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply multiple position buffers taught by Taylor to Horvitz's system to redirect the results of the first application to an alternate display buffer and to store pictorial representations of the results of the second application in the current display buffer with

the motivation being to enable the system to properly display the result of the second application and not the first application.

8.   Claims 8-10 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz, Taylor, and Boneh.

Regarding claims 8 and 18, Horvitz and Taylor differ from the claim in that Horvitz and Taylor do not teach second application is on-line application nor teaches monitoring the apparatus for being connected on-line. However, such feature is known in the art as taught by Boneh. Boneh teaches a system for updating a web page with rapidly changing information (col 3, lines 31-32). Boneh teaches that the system includes an invisible pane and a visible pane wherein the visible pane is updated with the status of the on-line application (col 4, lines 5-16). It would have been obvious to one of ordinary skill in the art, having the teaching of Horvitz, Taylor, Boneh before him at the time the invention was made to include a web-browser as a windows applications in Horvitz's desktop with the motivation being to enable world wide web access for Horvitz's desktop.

Regarding claims 9-10 and 19-20, when the user select the first application again for display, the system of Horvitz would then resume storing the pictorial representations of the results of the first application in the current or standard display buffer.

Response to Argument

9.   Applicant's arguments filed 08/03/04 have been fully considered but they are not persuasive.

In response to Applicant's argument "Note that the claim language does not call not "morphing" of windows or planes, but a face of a metaphoric desktop," it is noted that according to Merriam-Webster's Collegiate Dictionary Tenth Edition, a "face" is "any of the plane surfaces that bounds a geometric solid". Therefore, window or plane in Horvitz is indeed a face.

In response to Applicant's argument "The "windows" of Horwitz' WORKSPACE are all rendered on the same "front" 2-D surface of a display surface" it is noted that such is not quite the case since windows of Horwitz are rendered on different surfaces (planes) in a virtual 3-D environment (see Fig. 3) (also see column 3 lines 22-44).

In response to Applicant's argument that, in Horwitz, "Since one front surface is used, there is no morphing between display surfaces" it is noted that such is not quite the case. The Applicant does not use the word "surface" in his claims; instead, the Applicant uses the word "face". As mentioned above, face is any of the plane surfaces that bounds a geometric solid, therefore, a window or plane of Horwitz is a face. Horvitz does teach more than one face (window or plane) is used and morphing (transforming) between faces (col 3, lines 22-55).

In response to Applicant's argument that "Horvitz clearly considers his 3D-logical WORKSPACE" to be different and distinct from a 2-D metaphoric desktop", it is noted that this argument is only Applicant's allegation and has no basis. Nowhere in the reference shows Horvitz teaches that his invention is different and distinct from a 2-D metaphoric desktop. On the contrary, the 3-D workspace seen in Fig, 3 is in fact a virtual 3-D workspace (see col.3, lines 1-3) generated on a 2-D display screen 15 (see

Fig. 3, also see col. 3, lines 56-63). In other words, the 3-D workspace seen in Fig. 3 is

simulated to provide a sense of depth for 2-D display screen (abstract). Furthermore,

Horwitz stated that his invention is "in conjunction with a conventional desktop computer

(col 6, lines 50-53). The cited portion of col 1, lines 51-55 "The ability to resize and

move windows as well as..." is an example of how a "conventional desktop computer"

works. It does not teach that Horwitz' invention is different and distinct from a 2-D

metaphoric desktop. Therefore, Horvitz's 3-D workspace is of a 2-D metaphoric

desktop. As also seen in Fig. 3, the front plane 38 and back plane 44 are of the 2-D

screen 15, i.e. 2-D metaphoric desktop.

In response to Appellant's argument on the emphasis of "2-D metaphoric

desktop", it is noted that the 2-D characteristics is not claimed.

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(2-D, surface, morphing surface) are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed.

Cir. 1993).

10.   The prior art made of record on form PTO-892 and not relied upon is considered

pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to

consider these references fully when responding to this action.

Plow et al (USP 6429883) teaches system for viewing the contents of an

application window that would otherwise be hidden.

Frank et al (USP 5651107) teaches system for merging multiple images such that underlying windows may be rendered visible to the user.

Contact Information

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu.

The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 703-605-1232 through the month of October, 2004 and at 571-272-4057 thereafter.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 703-308-3116 through the month of October, 2004 and at 571-272-4048 thereafter.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

703-872-9306

and / or:

703-746-5639 through the month of October, 2004 and 571-273-4057 thereafter (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Art Unit: 2173

Kieu D. Vu

09/20/04